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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KATHERINE E. HAYES,
MARK A. SMITH, and JAY GLASPY

Appeal 2008-3881
Application 09/750,603
Technology Center 3600

Decided: November 17, 2008

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Hayes, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-23. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.¹

THE INVENTION

The Appellants claim a configurable billing system for a machine, which outputs a product. The machine has a plurality of aspect sensors, which detect the delivery of aspects of the product or service and report the delivery to the billing system, which tallies aspects of the output of the machine. (Specification 3:17-21.) “The billing system comprises a coded billing strategy delivered by the machine to the billing system, and a plurality of meters updated by the billing system for recording the delivery of the aspects of the product or service in a manner described by the billing strategy.” (Specification 3:20-24.) “[A] first billing strategy 210 comprises, for example, a list of parameters 214 or aspects of interest and a list of meter descriptions 218. The parameter list 214 is arbitrarily long and contains parameters, for example, P1 through Pn. The parameter list 214 informs the billing module 130 of the billable events or activities a marker module is capable of reporting.” (Specification 6:11-15). “The meter description 218 portion of the strategy specification 210 is also arbitrarily long and contains, for example, meter descriptions M1 through Mn. In general, the meter descriptions are expressed in the form of functions f() of the parameters P1 through Pn.” (Specification 7:25-28.)

¹ Our decision will make reference to Appellant’s Appeal Brief (“App. Br.,” filed April 27, 2007), Reply Brief (“Reply Br.,” filed October 24, 2007), and the Examiner’s Answer (“Ans.,” mailed August 22, 2007).

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A configurable billing system for a machine, the machine operative to output a product or service and including a plurality of aspect sensors, the sensors operative to detect the delivery of aspects of the product or service and to report the delivery to the billing system, the billing system comprising:

a coded billing strategy including an arbitrarily long list of aspects of interest and an arbitrarily long list of meter descriptions defined for the machine; and

a plurality of meters updated by the billing system for recording the delivery of the aspects of the product or service based on the billing strategy, whereby the billing system tallies the aspects in a manner defined in the billing strategy.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Maruta US 6,516,157 B1 Feb. 4, 2003

The following rejections are before us for review:

1. Claims 1-18, 20, and 23 are indefinite under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention.
2. Claims 1-7, 16, 17, and 19-23 are rejected under 35 U.S.C. § 102 as being anticipated by Maruta.
3. Claims 8-15 and 18 are rejected under 35 U.S.C. § 103 as being unpatentable over Maruta.

ISSUES²

The first issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 1-18, 20 and 23 under 35 U.S.C. § 112, 2nd paragraph. The issue turns on the definiteness of the claim phrase “arbitrarily long.”

The second issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 1-7, 16, 17, and 19-23 under 35 U.S.C. § 102. The issue turns predominantly on Maruta’s description of 1) a copy operation occurring after confirmation is made of the indicated cost, and whether Maruta describes 2) a configurable billing system, and 3) an arbitrarily long list of aspects and meter descriptions.

The third issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 8-15 and 18 under 35 U.S.C. § 103. The issue turns on whether the Official Notice taken by the Examiner “that many aspects of interest can be used for billing” (Ans. 6) is a general allegation that fails to point a “reference that is combinable with Maruta” (App. Br. 40.)

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

² The Appellants also request entry of an after final amendment (submitted Sept. 28, 2006). (See App. Br. 41.) Such request should be made via petition to the proper authority. *See* 37 C.F.R. § 1.181 (2007).

Claim construction

1. Claim 1 recites “an arbitrarily long list of aspects of interest and an arbitrarily long list of meter descriptions.”
2. The Specification does not provide an explicit definition for “arbitrarily.”
3. The ordinary and customary meaning of “arbitrarily” is “not fixed by rules but left to one’s judgment or choice; discretionary.” *See Webster’s New World Dictionary* 70 (3rd Ed. 1988.)(Entry 1. for “arbitrary”; adv.).
4. The Specification states “[t]he meter description 218 portion of the strategy specification 210 is also arbitrarily long and contains, for example, meter descriptions M1 through Mn.” (Specification 7:25-26.)
5. The Specification states “[t]he parameter list 214 is arbitrarily long and contains parameters, for example, P1 through Pn.” (Specification 6:13-14.)
6. The Specification states “[t]he parameter list used is a function of the type of copy machine used. (Specification 6:7-12.)

Anticipation

7. Claim 1 recites “sensors operative to detect the delivery of aspects of the product or service and to report the delivery to the billing system.”
8. Claim 1 recites “[a] configurable billing system.”
9. Maruta describes two embodiments of the invention.
10. In the first embodiment, Maruta describes that alternate structures can be provided. (Col. 11, ll. 4-18.)

11. Maruta describes that “... the contents, sequence, and division of the process of respective flow charts can be modified appropriately according to the concept of the present invention” (col. 25, ll. 39-42).
12. Maruta describes that “... the structure, circuitry, function, operation method, process contents, and sequence of user side data processor 5, center side data processor 4, and copy machine 3 can be modified appropriately . . . according to the concept[s] of the present invention” (col. 25, ll. 36-39).
13. Maruta discloses four aspects of interest (color small, color large, black-and-white small, black-and-white large) and a corresponding counter for each. (Col. 9, ll. 25-28.)
14. Claim 2 recites “information regarding a format in which information regarding the aspects of interest will be communicated.”
15. Maruta in “Fig. 18 shows an example of a structure of image printing information stored in a center side data processor” (col. 4, ll. 61-62.)
16. Claim 3 recites, “each meter in the list of meters is described as a function of at least one of the listed aspects of interest.”
17. Maruta discloses that “[t]he count value of the counter corresponding to each type of document is incremented every time a relevant document is read by a pre-scanning operation” (col. 9, ll. 31-33).
18. One type of meter function the Specification describes is $M1 = M1 + P5$. (See Specification 8.)

19. Claim 5 states: “wherein the plurality of meters are instantiated in memory, by the billing system, according to the coded billing strategy.”
20. According to Maruta, “the program for implementing the printing system is stored in the hard disk of the data processor” (col. 25, ll. 23-25).
21. Also, Maruta discloses that
 - [a] program BP for implementing printing system 1 through the processes of center side data processor 4, image print information PD sent from user side data processor 5, ID code UC generated at center side data processor 4, and the like are stored in memory device 41 such as a hard disk or memory provided in the main unit of center side data processor 4 (col. 12, ll. 59-65).
22. Claim 16 calls for “a machine readable script for updating the meters defined in the list.”
23. The Specification does not provide an explicit definition for the claim term “update.” The ordinary and customary meaning of “update” is “to bring up to date; make conform to the most recent facts, methods, ideas, etc.” *See Webster's New World Dictionary* 1466 (3rd Ed. 1988.)(Entry for “update”).
24. Claim 17 calls for “wherein the marker module is operative to deliver the billing strategy to the billing system.”
25. Maruta describes a printer controller. (Col. 5, l. 59-col. 6, l. 59) and copy machine (Col. 13, ll. 12-20).

26. Claim 20 calls for “a means for loading the custom billing strategy file.”
27. According to the Specification: “Alternatively, a billing module may read this information directly from files and/or sensors” (Specification 6:3-4).
28. The Specification states that a network is another possible architecture for reporting information to the billing module 130. (Specification 12:20-21.)
29. Maruta describes a “[c]ommunication line 6 [which] may be, for example, a public analog line, digital line, private line, or a network such as LAN, WAN, and Internet” (col. 11, ll. 43-45).
30. Maruta also describes “[t]he program and data stored in hard disk 54 can be loaded appropriately to the main memory” (col. 12, ll. 21-22).
31. Claim 23 calls for “a billing strategy file defining a billing strategy in machine readable form.”
32. Maruta describes a copy operation sequence. (Col. 10, ll. 3-4 and col. 10, ll. 43-63.)
33. While Maruta does describe that the sensors transmit information to the billing system, it is the copy control, not the marker module, which delivers information to the billing system.

Obviousness

34. Maruta describes various print conditions such as number of prints, output color, duplex output, staple, punch, the sheet size, picture quality, and the like. (Col. 16, l. – col. 17, l. 3.)

35. Maruta describes that various printer devices that allow print out of image file DF can be used. (Col. 25, ll. 33-35.)

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.

In re ICON Health and Fitness, Inc., 496 F.3d 1374, 1379 (Fed. Cir. 2007). "[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted).

Definiteness

The test for compliance is whether the claims set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the application disclosure as they would be interpreted by

one of ordinary skill in the art. *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971).

Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Ca.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 1-18, 20, and 23 under 35 U.S.C. § 112.

The Examiner rejected claims 1-18, 20, and 23 under 35 U.S.C. § 112, 2nd paragraph, on the ground that the claim phrase “arbitrarily long” is indefinite (see e.g., claim 1: “a coded billing strategy including an *arbitrarily long* list of aspects of interest and an *arbitrarily long* list of meter descriptions defined for the machine”)(emphasis added). According to the Examiner, “[a]rbitrarily/arbitrary can be interpreted based on various definitions and consequently the metes and bounds of the claims are confusing and not obvious to one of ordinary skill in the art.” (Ans. 9.) The Appellants disagreed. The Appellants argued that one of ordinary skill in the art would know “that an arbitrarily long list would have a length depending on choice or discretion based on convenient selection or choice.” (App. Br. 17.)

We agree with the Appellants. While the phrase “arbitrarily long” may be broad, we do not find it indefinite. “[B]readth is not to be equated with indefiniteness.” *In re Miller*, 441 F.2d 689, 693 (CCPA 1971).

The Specification does not provide an express definition of “arbitrarily.” (FF 2.) Accordingly, we will give it its ordinary and customary meaning, which is “not fixed by rules but left to one’s judgment or choice; discretionary.” (FF 3.) This meaning is consistent with the description of invention set forth in the Specification. The Specification describes an arbitrarily long list of aspects, represented by P1 through Pn (FF 5), and an arbitrarily long list of meters, represented by M1 through Mn (FF 4), the values for which depend on the type of copy machine used. (FF 6.) Depending on one’s choice, an aspect and meter can be selected from the lists. In our view, one of ordinary skill in the art reading the claims would understand the scope of the claimed invention to encompass lists of any

length which provide a choice of aspect and meter for the billing strategy. While we recognize that the claimed lists may be of any length which may make it difficult to ascertain how many choices the claimed subject matter encompasses, this *per se* does not render the claims indefinite. “If the meaning of the claim is discernible, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds.” *Exxon Research & Eng’g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001) (citations omitted). In that regard, we find the claims are sufficiently clear, notwithstanding the breadth of the claim limitation “arbitrarily long.”

Accordingly, we find that the Appellants have shown that the Examiner erred in rejecting claims 1-18, 20, and 23 under the second paragraph of 35 U.S.C. § 112 and thereby reverse the rejection.

The rejection of claims 1-7, 16, 17, and 19-23 under 35 U.S.C. § 102 as being anticipated by Maruta.

Claims 1 and 6

The Appellants argued claims 1 and 6 as a group (App. Br. 24). We select claim 1 as the representative claim for this group, and the remaining claim 6 stands or falls with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants argue that Maruta does not anticipate the claims because: 1) Maruta describes that the copy operation occurs after confirmation is made of the indicated cost, 2) Maruta does not describe a configurable billing system and 3) Maruta does not describe an arbitrarily long list of aspects and meter descriptions. (App. Br. 23-25.)

First, the Appellants argue that Maruta does not anticipate the claims because the copy operation in Maruta occurs after the cost is calculated, while in Appellants' invention, the billing system performs the cost calculation after the copies are delivered. (See App. Br. 24.)

We are not persuaded by this argument because claim 1 does not include a limitation related to when the billing system calculates the cost, but merely requires that the sensors report the delivery of aspects of the product or service to the billing system. (FF 7.) Thus the claim is not limited so as to exclude the copy operation from occurring after the cost is calculated as Maruta describes. The delivery of the product is not required to be reported to the billing system and, therefore, claim 1 does not require that the copies be delivered before the billing system perform cost calculations. The Appellants' argument is thus not commensurate in scope with what is claimed but rather based on limitations not found in the claim. *Cf. In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) ("Many of appellant's arguments fail from the outset because, . . . they are not based on limitations appearing in the claims") Accordingly, we find that the Appellants have not shown by this argument that the Examiner erred in rejecting claim 1 under § 102.

Second, the Appellants argued that Maruta does not describe a configurable billing system because Maruta does not suggest or describe that the four counters are anything but of the hard coded variety. (App. Br. 23.)

We are not persuaded by this argument because claim 1 does not require that the meters (considered to be the counters in Maruta) in the billing strategy or that meter definitions coded into the billing strategy are configurable, but merely that the billing system is configurable. Claim 1 only requires a configurable billing system, not a configurable billing

strategy or a configurable billing meter. (FF 8.) The claim does not limit which elements of the billing system are configurable or when or how the billing system is configurable. Claim 1 therefore broadly encompasses any configurable billing system. In that regard, Maruta describes a billing system which can be configured according to one of two embodiments (FF 9) and describes a structure of a system that can be altered (FF 10) and modified (FF 11,12), and thus anticipates the claimed configurable billing system. Because the Appellants' argument is not commensurate with the scope of claim 1, we find that the Appellants have not shown by this argument that the Examiner erred in rejecting claim 1 under § 102.

Third, the Appellants argue that Maruta does not describe an arbitrarily long list of aspects and meter descriptions. The Appellants stated: "Maruta does not disclose or suggest a method for allowing such lists to be arbitrarily long." (App. Br. 25.)

In our decision to reverse the Examiner's rejection under the second paragraph of 35 U.S.C. § 112 (see *supra*, pp.11, 12), we gave the claim term "arbitrarily" its ordinary and customary meaning of not being fixed by rules but being left to one's judgment or choice; i.e., discretionary. Accordingly, it would follow that an arbitrarily long list encompasses a list of a length of aspects and meters based on one's choice, and that would cover any number of aspects and meters. Maruta describes a list of four aspects and four counters. (FF 13.) Such a list falls within the possible choice of list lengths that the claimed arbitrarily long list encompasses. Thus, Maruta's list anticipates the broadly claimed arbitrarily long list. Accordingly, we find that the Appellants have not shown by this argument that the Examiner erred in rejecting claim 1 under § 102.

Claim 2

The Appellants argued that the Examiner erred in rejection claim 2 under § 102 because Maruta does not describe a coded billing strategy that further comprises information regarding a format in which information regarding the aspects of interest will be communicated. (App. Br. 25.)

This argument is not persuasive as to error in the rejection because Maruta does describe information regarding a format in which information regarding the aspect of interest will be communicated. Figure 18 of Maruta provides an example of a structure for image printing information. (FF 16.) Accordingly, we find that the Appellants have not shown by this argument that the Examiner erred in rejecting claim 2 under § 102.

Claim 3

The Appellants argued that the Examiner erred in rejecting claim 3 under § 102 because Maruta does not describe each meter in the list of meters as a function of at least one aspect of interest. (App. Br. 26.)

This argument is not persuasive as to error in the rejection because the Appellants do not explain and we do not see the difference between Maruta's meters and those claimed. Maruta describes that a count value of the counter (i.e., meter) for each type of document (i.e., aspect) is incremented every time a relevant document is read. (FF 17.) The $M1 = M1 + P5$ meter described in the Appellants' Specification also increments for an aspect of interest; P5 represents the number of impressions made. (FF 18.) Accordingly, we find that the Appellants have not shown by this argument that the Examiner erred in rejecting claim 3 under § 102.

Claim 4

The Appellants argued that the Examiner erred in rejecting claim 4 under § 102 because Maruta does not describe information associated with a listed meter, which describe the function of the meter. (App. Br. 26.) As explained above with regard to the rejection of claim 3, we find that Maruta describes a counter that is incremented as a function of the type of document. Thus, Maruta *does* describe information associated with a listed meter, which describe the function of the meter. Accordingly, we find that the Appellants have not shown by this argument that the Examiner erred in rejecting claim 4 under § 102.

Claims 5 and 7

The Appellants argued claims 5 and 7 as a group (App. Br. 26.) We select claim 5 as the representative claim for this group, and the remaining claim 7 stands or falls with claim 5. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants argued that the Examiner erred in rejecting claim 5 under § 102 because Maruta does not describe a plurality of meters instantiated in memory by a billing module according to a billing strategy or description. (App. Br. 26.)

We find this argument unpersuasive as to error in the rejection because the program (i.e., billing strategy) Maruta describes includes meters stored in a hard disk or memory. (See FFs 19-21.) Thus, Maruta describes meters instantiated in memory by a billing module in the manner claimed. Accordingly, we find that the Appellants have not shown by this argument that the Examiner erred in rejecting claim 5 under § 102. Because claim 7

falls with claim 5, we find that the Appellants have not shown by this argument that the Examiner erred in rejecting claim 7.

Claims 16, 19 and 22

The Appellants argued claims 16, 19 and 22 as a group (App. Br. 27). We select claim 16 as the representative claim for this group, and the remaining claims 19 and 22 stand or fall with claim 16. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants argued that the Examiner erred in rejecting claim 16 under § 102 because Maruta does not describe a machine readable script for updating the meters. Appellants state: “Furthermore, Maruta does not disclose or suggest a billing strategy including a machine-readable script for updating the meters defining the list.” (App. Br. 32-33.)

We do not find this argument persuasive as to error in the rejection because claim 16 does not require that the meter *descriptions* be updated. Only the *meters* need to be updated. Claim 16 states, “a machine readable script for updating the meters defined in the list to record the occurrence of document production events as described in the billing strategy specification.” The ordinary and customary meaning of “update” is “to bring up to date; make conform to the most recent facts, methods, ideas, etc.” (FF 23.) Maruta describes that a count value of the counter (i.e., meter) for each type of document (i.e., aspect) is incremented every time a relevant document is read. (FF 17.) This updates the meter. The meter records an occurrence of a document production event and is thus updated.

The Appellants also repeated the three arguments raised in challenging the rejection of claim 1. For the same reasons we found those

argument unpersuasive as to error in the rejection of claim 1, we find them similarly unpersuasive as to error in the rejection of claim 16.

Accordingly, we find that the Appellants have not shown by these arguments that the Examiner erred in rejecting claim 16 under § 102. Because claims 19 and 22 fall with claim 16, we find that the Appellants have not shown by these arguments that the Examiner erred in rejecting claims 19 and 22.

Claim 17

The Appellants argued that the Examiner erred in rejecting claim 17 under § 102 because Maruta does not describe a marker module delivering a billing strategy to a billing system. (App. Br. 29.) The Examiner cited to disclosure at column 10, lines 43-63, of Maruta as evidence that the subject matter of this limitation was shown in the Maruta. (Ans. 5.)

Claim 17 states: “wherein the marker module is operative to deliver the billing strategy to the billing system.” While Maruta describes a copy machine, which could be considered the marker module (see FF 25) and which includes a billing strategy, Maruta does not describe that the marker module is structured to deliver the billing strategy to the billing system, as claimed. The disclosure in Maruta cited by the Examiner describes a billing strategy but does not describe the structure of the copy machine or what it is operative to do. In Maruta, the cost is determined by the billing system before the copies are made. While Maruta does describe that the sensors transmit information to the billing system, it is the copy control, not the marker module, which delivers information to the billing system. (FF 33.) Maruta thus does not describe a marker module that is structured to deliver

the billing strategy to the billing system. Accordingly, Maruta does not identically describe the subject matter described in claim 7 and thus fails to anticipate claim 17. For this reason, we find that the Appellants have shown that the Examiner erred in rejecting claim 17 under § 102 over Maruta.

Claim 20

The Appellants argued that the Examiner erred in rejecting claim 20 under § 102 because Maruta does not describe a means for loading a custom billing strategy file. (App. Br. 34.) The Appellants point to page 6, lines 1-10 and to page 12, lines 20-21 of the Specification (App. Br. 10) which describe the structure of the means for loading a custom billing strategy file as a file, sensor, or network. (FFs 27 and 28.) In that regard, Maruta describes that the billing program can be loaded into memory through a *network*. (FFs 29 and 30.) Accordingly, we do not find this argument persuasive as to error in the rejection of claim 20.

The Appellants also argued that the Examiner erred in rejecting claim 20 because the billing system of Maruta is not configurable. We previously addressed this argument during our review of the rejection of claim 1 (*see supra*, pp. 13, 14). We find the argument unpersuasive as to error in the rejection of claim 20 for the same reasons we found it unpersuasive as to error in the rejection of claim 1.

Accordingly, we find that the Appellants have not shown by these arguments that the Examiner erred in rejecting claim 20 under § 102.

Claim 21

The Appellants argued that the Examiner erred in rejecting claim 21 under § 102 because 1) Maruta does not describe a machine-readable script and 2) Maruta describes that the copy operation occurs after confirmation is made of the indicated cost. (App. Br. 35.)

We previously addressed these arguments during our review of the rejection of claims 16 and 1, respectively (*see supra*, pp. 17, 13). We find the arguments unpersuasive as to error in the rejection of claim 21 for the same reasons we found them unpersuasive as to error in the rejection of claims 16 and 1.

Accordingly, we find that the Appellants have not shown by these arguments that the Examiner erred in rejecting claim 21 under § 102.

Claim 23

The Appellants argued that the Examiner erred in rejecting claim 23 under § 102 because Maruta does not describe a billing strategy file. (App. Br. 35-36.) However, Maruta does describe a copy operation sequence, which calculates the cost. (FF 32.)

In addition, the Appellants argued that the Examiner erred in rejecting claim 23 because Maruta does not describe an arbitrarily long list of aspects and meters. We previously addressed this argument during our review of the rejection of claim 1 (*see supra*, pp. 14, 15). We find the argument unpersuasive as to error in the rejection of claim 23 for the same reason we found it unpersuasive as to error in the rejection of claim 1.

Accordingly, we find that the Appellants have not shown by this argument that the Examiner erred in rejecting claim 23 under § 102.

The rejection of claims 8-15 and 18 under 35 U.S.C. § 103.

The Appellants argued that the Examiner erred in rejecting claims 8-15 and 18 under § 103 because 1) they depend from claim 6 or 16, which is not anticipated (App. Br. 40), 2) the Official Notice amounts to general allegations without pointing to a specific reference (App. Br. 40), and 3) the Examiner has provided no motivation (Reply Br. 12).

The first argument is not persuasive as to error in the rejection because, for the foregoing reasons, we found that the Appellants have not shown error in the rejection of claims 6 and 16 under § 102 over Maruta.

Regarding the second argument, to the extent that we understand the Appellants to be arguing that the Examiner's use of Official Notice amounts to a general allegation that is not proper because it is not supported by a reference (App. Br. 40), we find it unpersuasive. The Appellants did not seasonably traverse the Examiner's taking of Official Notice. *See In re Chevenard*, 139 F.2d 711, 713 (CCPA 1943) ("In the absence of anything in the record to contradict the examiner's holding, and in the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). The Examiner first used Official Notice in the Non-Final Rejection mailed April 24, 2006. The Appellants responded with a Response filed on May 30, 2006 which did not seasonably traverse the Official Notice. Accordingly, the object of the Official Notice is taken to be admitted prior art.

With respect to the third argument, the Appellants argued that the Examiner provided no motivation (Reply Br. 12) to lead one of ordinary skill in the art to include different aspects or to make the copy machine a different type.

The Examiner stated that one of ordinary skill in the art would modify Maruta to include specialized characteristics because the cost can be calculated based upon them. (Ans. 7.) Further, Maruta recognizes that a cost can be based on a list of print conditions such as staples, punches, duplex output and the like. (FF 34.) Also, the Examiner stated that one of ordinary skill the art use a xerographic printer because they are commonly used. Again, Maruta recognizes that the copy machine 3 can be modified (FF 12) and that various printing devices could be used (FF 35). We are satisfied that the Examiner has articulated an apparent reasoning with logical underpinning that would lead one of ordinary skill in the art, given Maruta, include different aspects or to make the copy machine a different type.

Accordingly, we find that the Appellants have not shown that the Examiner erred in rejecting claims 8-15 and 18 under § 103 over Maruta.

CONCLUSIONS OF LAW

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 1-18, 20 and 23 as indefinite under 35 U.S.C. § 112, second paragraph and rejecting claim 17 as anticipated under 35 U.S.C. § 102, and that the Appellants have not shown that the Examiner erred in rejecting claims 1-7, 16 and 19-23 under 35 U.S.C. § 102 as being anticipated by Maruta and rejecting claims 8-15 and 18 under 35 U.S.C. § 103 as unpatentable over Maruta.

DECISION

The decision of the Examiner to reject claims 1-23 is affirmed-in-part. No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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